

REMARKS

In the Office Action, claims 1-2, 5-14 and 42 were objected to and claims 1, 2, 5-14, 23, 24, 26-28, 41-53, and 55-58 were rejected under 35 U.S.C. §103 in view of various cited references. After careful review of the cited references, claims 1, 2, 5-14, 23, 24, 26-28, 41-53, and 55-58 are believed to be clearly patentable over the various proposed combinations. However, Applicants have amended claims 1, 41, 42, 46 and 51 to remedy certain clerical errors and clarify certain aspects of the claims. Accordingly, Applicants respectfully traverse the rejections and request reconsideration of the present application in view of the arguments below.

Legal Precedents

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Furthermore, Applicant reminds the Examiner that, during patent examination, the pending claims must be given an interpretation that is *reasonable* and *consistent* with the specification. *See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. That is, recitations of a claim must be read as they would be interpreted by those of ordinary skill in the art. *See Rexnord Corp. v. Laitram Corp.*, 60 U.S.P.Q.2d 1851, 1854 (Fed. Cir. 2001); *see also* M.P.E.P. § 2111.01.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1, 2, 5-14, 23, 24, 26-28, 41-53, and 55-58 under 35 U.S.C. § 103(a) as being unpatentable over various cited references and assertions. Specifically, claims 1, 5, 10, 11, 14, 51 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,891,035 to Wood et al. (herein referred to as the “Wood” reference or as “Wood”) in view of U.S. Pat. No. 5,260,999 to Wyman (herein referred to as the “Wyman” reference or as “Wyman”) and the Examiner’s assertions relating to the duplication of known parts. Claims 2, 6, 8, 9, 12, 23, 24, 26, 41-43, 53, 55 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman and Official Notice. Claims 7, 44 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, U.S. Pat. No. 5,852,812 to Reeder (herein referred to as “the Reeder reference” or as “Reeder”), and Official Notice. Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, Official Notice and U.S. Pat. No. 6,504,571 to Narayanaswami et al. (herein referred to as “the Narayanaswami reference” or as “Narayanaswami”). Claim 46 was rejected as being unpatentable over Wood in view of Wyman and U.S. Pat. No. 6,343,124 to Munoz (herein referred to as “the Munoz reference” or as “Munoz”). Claim 27, 28, 47, 57 and 58 were rejected as being

unpatentable over Wood in view of Wyman, Munoz, and Official Notice. Claims 48, 49 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, Official Notice, Munoz and Admitted Prior Art. Applicants respectfully traverse each of the rejections.

Because these combinations fail for similar reasons, Applicants will discuss the independent claims together. Further, Applicants will discuss the dependent claims together. Finally, Applicants will discuss the Examiner's extensive use of Official Notice in the rejections.

1. Independent Claims

In the Office Action, the Examiner rejected independent claims 1 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman and the Examiner's assertions relating to the duplication of known parts. Independent claims 23 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman and Official Notice. Finally, independent claim 46 was rejected as being unpatentable over Wood in view of Wyman and Munoz. Applicants respectfully traverse each of the rejections.

To begin, each of the independent claims includes recitations that describe the selection of a protocol based on a user viewable indicia. For example, claim 1 recites:

displaying user viewable indicia descriptive of at least one of the plurality of different modality protocols at a medical diagnostic location on one of the first and second modality diagnostic systems;
selecting the at least one of the plurality of protocols via a user interface.

Claim 23 recites:

displaying indicia descriptive of the at least two protocols in a protocol menu of a user interface on the first or the second diagnostic system;

selecting one of the at least two protocols from the menu.

Claim 41 recites:

viewing at least one of a plurality of protocol lists on a user interface at a first medical diagnostic system of a first modality and a second medical diagnostic system of a second modality;

selecting a desired protocol from the at least one of the plurality of protocol lists based at least partially on a user viewable indicia descriptive of the desired protocol.

Claim 46 recites:

at least one storage device for storing data defining a first modality protocol and a second modality protocol, wherein the at least one storage device stores a user viewable indicia descriptive of the first modality protocol and the second modality protocol for selecting one of the first modality protocol or the second modality protocol.

Claim 51 recites:

displaying the description of the plurality of protocols at one of the first medical diagnostic system and a second medical diagnostic system, wherein the description comprises a user viewable indicia descriptive of the plurality of protocols and configured to be utilized in the selection of one of the plurality of protocols.

With these recitations in mind, the various combinations fail to render the independent claims obvious. First, the Examiner is improperly using hindsight reconstruction to assert that Wood teaches utilizing user viewable indicia to select a protocol. Second, the cited references and Examiner's assertions about the mere duplication of known parts does not disclose or teach a first and second modality. Finally, the Wyman reference is non-analogous art.

A. Improper Use of Hindsight Reconstruction

In the rejection, the Examiner asserted that the Wood reference discloses the selection of a protocol based on the user viewable indicia. However, Applicants respectfully submit that the Examiner's assertions are based on improper hindsight reconstruction. In fact, the Examiner's assertions about the Wood reference were recently reversed by the Board in a Decision on Appeal for, a related application U.S. Patent Application Serial No. 09/476,708, which is attached as Appendix A and herein referred to as the "Decision." The Decision was provided in a divisional application of the present application, dealing with similar references. In the Decision, the Board held that the exemplary images of the Wood reference are found at the diagnostic end of the Wood process. *See* Appendix A, p. 9. As a result, the Board held that moving these exemplary images to the front of the Wood process is improper hindsight reconstruction. *See id.* Clearly, the Examiner is utilizing the exemplary images of Wood in the same manner in the present claims. As such, Applicants respectfully assert that the Examiner has improperly utilized hindsight reconstruction in an attempt to demonstrate obviousness of the claimed subject matter.

Furthermore, the Wyman and Munoz references along with the Examiner's assertions and use of Official Notice fail to cure the deficiencies of the Wood reference. The Wyman reference describes a license management system for software products. *See* Wyman, col. 6, lines 43-61. The Munoz reference describes a telephone networking system that provides certain functionalities in equipment that is located closer to customer locations. *See* Munoz, col. 2, lines 9-28. Neither of the references teaches the selection of a protocol based on the user viewable indicia. Further, the Examiner's assertions and reliance on Official Notice do nothing to cure this deficiency. As such, the Wood, Wyman, and Munoz references along with Examiner's assertions and Official Notice do not disclose or teach the claimed subject matter.

B. References Fail to Disclose a First and Second Modality

Further, each of the independent claims includes recitations regarding diagnostic systems of a first and second modality. In the rejection, the Examiner admitted that the Wood reference does not disclose storing a plurality of different modality protocols. In an attempt to cure this deficiency, the Examiner suggested that this feature constitutes mere duplication of essential parts, which the Examiner asserts is based on the holding from *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 U.S.P.Q. 8 (7th Cir. 1977), to disclose the claimed subject matter.

However, the Examiner's reliance on *St. Regis Paper Co.* is misplaced. Specifically, in *St. Regis Paper Co.*, the court held that placing multiple bags together to form a single multilayer bag is not novel because using multiple bags together was known in the bag industry. *See St. Regis Paper Co.* at 11. That is, each of the bags was taken as a complete unit and combined together for the known purpose of strengthening the entire bag structure. This benefit was *admitted by the patentee* to be known to others prior to the patent, thus providing the *evidence* required to support the holding. *See id.*

In the present rejection, the Examiner asserts that one of ordinary skill in the art would modify Wood to store a plurality of different modality protocols and provide these different modality protocols to several diagnostic systems. However, unlike the cited case, Applicants have not admitted that a single system storing different modality protocols is known in the prior art to be equivalent to the single diagnostic system of Wood. At best, the Examiner's proposed combination would teach having two completely separate systems for each modality. Nothing in the Wood reference or holding of the *St. Regis Paper Co.* provide a single system that stores a plurality of different modality protocols and provides these different modality protocols to different diagnostic systems.

Moreover, the court in *St. Regis Paper* specifically recognized that synergistic values may be patentable. Specifically, the court explicitly allowed that duplication of parts known in the art can be patentable if the result is synergistic, or results in an effect that is greater than the sum of the several effects taken separately. *See id.* at 11. In the present application, providing protocols to a plurality of different modality diagnostic systems is synergistic. That is, by providing the protocols to diagnostic systems of different modalities, the value of the system is increased beyond a combination of individual systems dedicated to a single modality. For example, a system that provides multiple modalities is less complex in comparison to multiple systems that are each dedicated to a single modality. Accordingly, the Examiner's dismissal of the feature as mere duplication based upon *St. Regis Paper* is unfounded.

C. The Wyman Reference is Non-Analogous Art

Finally, for the reasons provided in the previous Response to Office Action mailed January 15, 2003, which are hereby incorporated by reference, the Wyman reference is clearly non-analogous art. As Wyman cannot properly be pertinent prior art under 35 U.S.C. § 103, the teachings of Wyman would not have been considered by one skilled in the particular art working on the particular problem with which the invention pertains. Furthermore, the reference is not even reasonably pertinent to the particular problem with which the Applicants are involved. As such, Applicants again respectfully submit that the Wyman reference is non-analogous art and, as such, is improper in the proposed combination.

Because the Examiner has improperly combined the references and the cited references along with Official Notice and the Examiner's assertions fail to show *all* of the claimed elements, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner withdraw the rejections and allow independent claims 1, 23, 41, 46 and 51, and the claims depending therefrom.

2. Dependent Claims

In the Office Action, the Examiner rejected claims 5, 10, 11, 14 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman and the Examiner's assertions relating to the duplication of known parts. Claims 2, 6, 8, 9, 12, 24, 26, 42-43, 53, 55 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman and Official Notice. Claims 7, 44 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, Reeder, and Official Notice. Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, Official Notice and Narayanaswami. Claim 46 was rejected as being unpatentable over Wood in view of Wyman and Munoz. Claim 27, 28, 47, 57 and 58 were rejected as being unpatentable over Wood in view of Wyman, Munoz, and Official Notice. Claims 48, 49 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Wyman, Official Notice, Munoz and Admitted Prior Art. Applicants respectfully traverse each of the rejections.

Claims 2, 5-14, 24, 26-28, 42-50, 52, 53 and 55-58 depend from independent base claims and are patentable at least based on this dependency. In the rejection, the Examiner asserted that the Wood and Wyman references disclose all of the claimed subject matter except for certain features. In an attempt to cure these deficiencies, the Examiner relied upon other references and Official Notice. However, the other references and Official Notice do not disclose at least the selection of a protocol based on the user viewable indicia and the multiple modalities of diagnostic systems. As such, the other references and Official Notice fail to cure the deficiencies of the Wood and Wyman references discussed above with reference to independent claims 1, 23, 41, 46 and 51.

For at least these reasons, the cited references clearly do not disclose or suggest each and every element set forth in the independent claims 1, 23, 41, 46 and 51, much less, the dependent claims 2, 5-14, 24, 26-28, 42-50, 52, 53 and 55-58. Therefore, the

Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of the pending claims 2, 5-14, 24, 26-28, 42-50, 52, 53 and 55-58.

3. Examiner's Improper Reliance on Official Notice

Furthermore, Applicants traverse the Examiner's use of Official Notice. To begin, Applicants would like to remind the Examiner that Official Notice is only proper where the facts asserted are "capable of instant and unquestionable demonstration as being well known. For example, assertions of technical facts in areas of esoteric technology or specific knowledge of the prior art *must always be* supported by citation to some reference work recognized as standard in the pertinent art." MPEP 2144.03; *In re Ahlert*, 424 F. 2d 1088, 1091; 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970) (emphasis added).

In the rejection, the Examiner utilized Official Notice for a variety of claims. For instance, the Examiner asserted that it is well known for indicia to include textual descriptions of programs or products in the rejection of claim 2. In the rejection of claim 6, the Examiner asserted that it is well known to store record data. In the rejection of claim 9, the Examiner asserted that it is well known to select icons, etc., from on-screen menus. In the rejection of claim 12, the Examiner asserted that it is well known to display indicia based on data (e.g., information in a catalog or products, or icons, titles, etc. on a computer screen indicating what data is in which files). In the rejection of claims 23 and 55, the Examiner asserted that menus in user interfaces and that displaying indicia descriptive of a product, program, or file are well known. In the rejection of claims 24 and 53, the Examiner asserted that it is well known for indicia to include textual descriptions of programs or products (e.g. catalog entries). In the rejection of claims 26 and 56, the Examiner asserted that it is well known to make selections by actuating a graphical button on an on-screen display. In the rejection of claims 27 and 57, the Examiner asserted that it is well known to transfer descriptions of products, programs,

or files for display. In the rejection of claim 41, the Examiner asserted that it is well known to view lists of items on a user interface and select a desired item from the list. In the rejection of claim 42, the Examiner asserted that it is well known to categorize information by relevance (e.g., listing spare parts, etc., for a particular car separately from parts for other cars). In the rejection of claim 47, the Examiner asserted that it is well known to initiate network links to data recipients from the communications circuitry at a data sender (e.g., pushing updated programs, or, for that matter, in sending e-mail).

In accordance with M.P.E.P. § 2144.03, Applicants hereby seasonably traverse and challenge the Examiner's use of Official Notice. Specifically, Applicants respectfully request that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the presently cited references, Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly "well known" elements of the instant claims.

In closing, Applicants respectfully remind the Examiner that he should "never overlook the importance of his or her role in allowing claims which properly define the invention." M.P.E.P. § 706. Here, the claims not only properly define certain aspects of the invention, they also clearly contain recitations that are not described, much less suggested, by any of the prior art of record. Accordingly, Applicants urge the Examiner to withdrawal the outstanding rejections and allow the pending claims.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: February 3, 2005

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Appendix A

✓ GEMS: 0036-1

YOD/KN1

15-SV-5482

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22



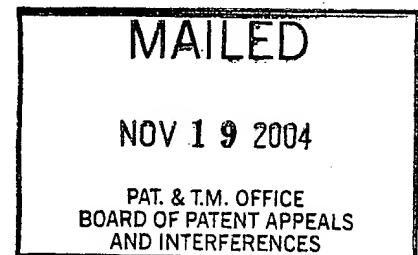
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IANNE MAE HOWARDS KORITZINSKY and JOHN AURTHUR REICH

Appeal No. 2004-2044
Application No. 09/476,708

ON BRIEF



Before SMITH, RUGGIERO, and MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 59-64 and 66-78. Claims 1-58 and 65 have been canceled.

Invention

Appellants' invention relates to a system and method for handling of imaging and diagnostic system protocols. The system may be integrated in a scanner interface which includes pages accessible through a browser-type or other graphical user

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interface system. At least one of the pages may be devoted to a listing and description of protocols installed on or available for the particular scanner. The technique may also be employed on centralized management stations, such as a station linking several scanners in a radiology department of a medical institution. The system may also provide information on preferred or useful configuration parameters for carrying out the protocol. The interface may also permit the protocol to be loaded or requested for specific examinations by simply selecting the protocol from a menu. In a preferred arrangement, new or improved protocols may be made available through an interactive communications system which links the scanners to a centralized service facility. The service facility may transmit messages to the scanner to inform the operations personnel of the existence and availability of the new protocol. The protocol may then be downloaded or transmitted automatically or upon request by the institution. The technique allows protocols for a large variety of scanners, scanner types, modalities, and manufacturers to be easily distributed through the service center. The service center may also provide a library of available protocols which may be installed on memory media or transmitted via a network. Accounting for distribution of the protocols may also be

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performed by the system, such as for transmitting protocols in accordance with subscriptions and so forth.

Claim 59 is representative of the claimed invention and is reproduced as follows:

59. A method for providing operational protocols to medical diagnostic systems, the method comprising the steps of:

storing a protocol on a machine readable medium, the protocol including at least one operation parameter for a medical diagnostic system;

displaying user viewable indicia descriptive of the protocol at a medical diagnostic location, wherein the user viewable indicia include an exemplary image obtainable via the protocol;

performing a protocol exchange transaction including selecting the protocol via a user interface and loading the protocol at the medical diagnostic location from the machine readable medium via a network connection to the medical diagnostic location; and

storing an accounting record of the transaction.

References

The references relied on by the Examiner are as follows:

Wyman	5,260,999	Nov. 9, 1999
Strauss et al. (Strauss)	5,790,173	Aug. 4, 1998
Reeder	5,852,812	Dec. 22, 1998
Pourjavid	5,883,985	Mar. 16, 1999
Wood et al. (Wood)	5,891,035	Apr. 6, 1999
Grate et al. (Grate)	5,956,483	Sep. 21, 1999
Clarke et al. (Clarke)	5,982,917	Nov. 9, 1999

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Ross et al. (Ross)	6,026,417	Feb. 15, 2000
Wyatt	6,041,411	Mar. 21, 2000
Kuwabara	6,065,136	May 16, 2000
Miller et al. (Miller)	6,151,696	Nov. 21, 2000
Sekiguchi	6,288,799	Sep. 11, 2001

Evans, W.S., "Compression via Guided Parsing" (Abstract only),
Proceedings [of the] DCC 1998 Data Compression Conference, page
544, edited by Storer, J.A., et al., published by the IEEE
Comput. Soc., 1998.

Rejections At Issue

Claims 59, 60, 66, and 68 stand rejected under 35 U.S.C.
§ 103 as being obvious over the combination of Wood et al. and
Reeder.

Claims 61 and 64 stand rejected under 35 U.S.C. § 103 as
being obvious over the combination of Wood et al. and Reeder and
Official Notice.

Claims 62 and 63 stand rejected under 35 U.S.C. § 103 as
being obvious over the combination of Wood et al. and Reeder and
Wyman.

Claim 67 stands rejected under 35 U.S.C. § 103 as being
obvious over the combination of Wood et al. and Reeder and Clark
et al.

Claims 69 and 71-73 stand rejected under 35 U.S.C. § 103 as
being obvious over the combination of Wood et al. and Reeder and
Official Notice.

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Claim 70 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Reeder and Official Notice and admitted prior art.

Claims 74-76 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al.

Claims 77-78 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Wood et al. and Official Notice.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 59-64 and 66-78 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal, the claims stand or fall together in eleven groupings:²

¹ Appellants filed an appeal brief on September 12, 2003. Appellants filed a reply brief on December 29, 2003. The Examiner mailed out an Examiner's Answer on October 21, 2003.

² Appellants state that Groups II-VI, VIII, and X-XI, each "stand with [their] independent claim, or will fall separately." We interpret this statement of Appellants as "stand or fall separately."

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Claims 59, 60, 66, and 68 as Group I;

Claims 61-64 and 67, as Groups II-VI;

Claims 69 and 71-73 as Group VII;

Claim 70 as Group VIII;

Claims 74-76 as Group IX; and

Claims 77-78 as Groups X-XI.

See pages 5-6 of the brief. Appellants have not explained why each group is believed to be separately patentable. Therefore, Appellants have failed to fully meet the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, **appellant explains why the claims of the group are believed to be separately patentable.** Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. (Emphasis added)

We will, thereby, consider Appellants' claims as standing or falling together in eight groups corresponding to the eight rejections at issue noted above, and we will treat:

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Claim 59 as a representative claim of Group I;
Claim 61 as a representative claim of Group II;
Claim 62 as a representative claim of Group III;
Claim 67 as a representative claim of Group IV;
Claim 69 as a representative claim of Group V;
Claim 70 as a representative claim of Group VI;
Claim 74 as a representative claim of Group VII; and
Claim 77 as a representative claim of Group VIII.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 59, 60, 66, and 68 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 59, 60, 66, and 68. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of

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obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

A) User viewable Indicia

With respect to independent claim 59, Appellants argue at pages 7-9 of the brief, "[t]he Wood et al. and Reeder references do not disclose or suggest "displaying user-viewable indicia descriptive of the protocol at a medical diagnostics location, wherein the user-viewable indicia include an exemplary image obtainable via the protocol." The Examiner rebuts this at pages 16-20 of the answer by pointing out that the reference images of Wood et al. are "exemplary images" and also meet the claim limitation of being "obtainable via the protocol." Further, the Examiner points out that the references images are also "descriptive of the protocol." We agree with the Examiner on all these points. However, we still find the Appellants' argument persuasive. The Examiner has taken the exemplary image of Wood et al. which is found at the diagnostic end of the Wood et al. process and moved the exemplary image to the protocol selection process at the front of the Wood et al. process. The Examiner states various reasons at page 7 of the answer for making this modification to the Wood et al. process. We find that this represents improper hindsight absent some teaching that it is known to select a process to be performed using an image exemplary of the result of said process to be performed. Although not an analogous art, an example of this type of process

selection can be found in the font change process of Microsoft Word where the resulting font is shown as an example during the selection process.

B) *Reeder is Non-Analogous Prior Art*

With respect to independent claim 59, Appellants argue at pages 9-12 of the brief, "[t]he Reeder reference is clearly completely unrelated to problems with respect to medical systems or access to image protocols." We do not find Appellants' argument persuasive. Appellants have improperly limited the field of art to medical systems or access to image protocols. We find that the invention is clearly directed to a combined medical diagnostics and billing system. We find that the analogous art properly includes both the Wood et al. and Reeder patents.

C) *Motivation or Suggestion to combine*

With respect to independent claim 59, Appellants argue at pages 12-13 of the brief, "[t]he Examiner's statements . . . [fail] to articulate a convincing line of reasoning as to why one of ordinary skill in the art would combine the references." We do not find Appellants' argument persuasive. As pointed out by the Examiner at page 6 of the answer, Reeder teaches storing accounting records for transactions such as downloading a file. The system of Wood et al. clearly performs such transactions. We

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find that more than sufficient motivation to combine exists within the four corners of the Wood et al. and Reeder patents.

Therefore, for the reason discussed at A) above, the Examiner has not met the initial burden of establishing a *prima facie* case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 61 and 64 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 61. Accordingly, we reverse.

With respect to dependent claim 61, we note that the Examiner has relied on Official Notice solely to teach "transmitting an authorization prompt" [answer, page 8]. Official Notice in combination with Wood et al. and Reeder fails to cure the deficiencies of Wood et al. and Reeder noted above with respect to claim 59. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

**III. Whether the Rejection of Claims 62-63 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 62. Accordingly, we reverse.

With respect to dependent claim 62, we note that the Examiner has relied on Wyman solely to teach "service subscription" [answer, page 9]. The Wyman reference in combination with Wood et al. and Reeder fails to cure the deficiencies of Wood et al. and Reeder noted above with respect to claim 59. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

**IV. Whether the Rejection of Claim 67 Under 35 U.S.C. § 103
is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 67. Accordingly, we reverse.

With respect to dependent claim 67, we note that the Examiner has relied on Clark et al. solely to teach "data for

filming" [answer, page 9]. The Clark et al. reference in combination with Wood et al. and Reeder fails to cure the deficiencies of Wood et al. and Reeder noted above with respect to claim 59. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

V. *Whether the Rejection of Claims 69 and 71-73 Under 35 U.S.C. § 103 is proper?*

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 69 and 71-73. Accordingly, we reverse.

A) *Features Missing from Proposed Combination*

With respect to independent claim 69, we find Appellants' argument with respect to the use of "lists" to be unpersuasive, as it does not address the combination rejection made by the Examiner. However, Appellants also argue at pages 16-18 of the brief that the references do not disclose or suggest use of "an exemplary image obtainable via the protocol." We find this argument persuasive for the reason noted above with respect to claim 59.

B) Reeder is Non-Analogous Prior Art

With respect to independent claim 69, Appellants argue at page 19 of the brief, "[t]he Reeder reference is non-analogous art." We do not find Appellants' argument persuasive for the reason noted above with respect to claim 59.

C) Motivation or Suggestion to combine

With respect to independent claim 69, Appellants argue at page 19 of the brief that there is no motivation or suggestion to combine the references. We do not find Appellants' argument persuasive for the reason noted above with respect to claim 59.

Therefore, for the reason discussed at A) above, the Examiner has not met the initial burden of establishing a *prima facie* case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

VI. Whether the Rejection of Claim 70 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 70. Accordingly, we reverse.

With respect to dependent claim 70, we note that the Examiner has relied on admitted prior art solely to teach "a

plurality of diagnostic system modalities" [answer, page 13].

The admitted prior art in combination with Wood et al. and Reeder and Official Notice fails to cure the deficiencies of Wood et al. and Reeder and Official Notice noted above with respect to claim 69. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

**VII. Whether the Rejection of Claims 74-76 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 74-76. Accordingly, we reverse.

With respect to independent claim 69, Appellants also argue at page 21-22 of the brief that the references do not disclose or suggest use of "an exemplary image obtainable via the protocol." We find this argument persuasive for the reason noted above with respect to claim 59.

Therefore, the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

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**VIII. Whether the Rejection of Claims 76-78 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 77-78. Accordingly, we reverse.

With respect to dependent claim 77, we note that the Examiner has relied on Official Notice solely to teach "a managing module within . . . the institution" [answer, page 14]. The Official Notice in combination with Wood et al. fails to cure the deficiencies of Wood et al. noted above with respect to claim 74. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

Other Issues

Should there be further prosecution of this application, we direct the Examiner's attention to:

A) Column 3, line 55, through column 4, line 42, of Stark et al. U.S. Patent 6,371,123 which teach selection of a medical protocol based on image and text data; and

B) Figures 29 and 30 of Hoium et al. U.S. Patent 5,951,484 which teach selection of medical protocol steps from a list.

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Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 59-64 and 66-78.

REVERSED

Gerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Joseph Ruggiero
JOSEPH E. RUGGIERO

JOSEPH F. RUGGIERO
Administrative Patent Judge

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